

Serial No.: 10/065,284
Attorney Docket No.: F-558

Patent

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REMARKS

AUG 14 2006

1. Status of Claims

Claims 1-17 were pending in the Application. Applicants have amended claims 1 and 12 and canceled claim 17, all without prejudice or disclaimer. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. The Amendments are submitted solely to place the present application in condition for allowance or in better condition for appeal. Applicants submit that no new matter is added. Accordingly, claims 1-16 will remain pending in the application.

2. Telephonic Interview

Applicants' undersigned attorney appreciates the courtesy extended by Examiner Schaffer and Examiner Mancuso during the August 2, 2006 telephonic interview. Applicants have amended claims 1 and 12 as discussed and acknowledge that the Examiner stated that it will be necessary for the Examiner to determine whether another search would be required upon review.

3. Rejections under 35 USC § 112

In section 5 of the Office Action, the Examiner rejected Claim 12 under 35 U.S.C. 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have canceled claim 17 without prejudice or disclaimer and the rejection is moot. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claim 17.

4. Rejections under 35 USC § 103(a)

In section 9 of the Office Action, the Examiner rejected Claims 1-16 under 35 U.S.C. 102(e) as allegedly rendered obvious by U.S. Patent No. 6,201,903 to Wolff, et al. ("Wolff '903") in view of McComb, et al. (Using WordPerfect ® 6.1 for Windows).

Serial No.: 10/065,284
Attorney Docket No.: F-558

Patent

Applicants respectfully traverse the rejection. However, solely in order to expedite prosecution, Applicants have amended claims 1 and 12 without prejudice or disclaimer and the rejection is moot. Initially, Applicants submit that one of skill in the art would not look to McComb to modify Wolff as they are not in the same field. Wolff does not appreciate the problem of selecting from multiple templates using the input data and therefore one of skill in the art would not be motivated to look to McComb to modify Wolff.

Regarding claim 1 and 12, Applicants respectfully submit that the combination of Wolff '903 and McComb does not teach or suggest:

composing the document using the document type data to select the form of the document from a selection of at least two Different form types, wherein the input form comprises a different format than the document and using the input data to populate the document.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 1-16.

In section 10 of the Office Action, the Examiner rejected Claim 17 under 35 U.S.C. 102(e) as allegedly rendered obvious by U.S. Patent No. 6,201,903 to Wolff, et al. ("Wolff '903") in view of U.S. Patent No. 5,903,667 to Kuzunuki, et al. ("Kuzunuki '667").

Applicants respectfully traverse the rejection. However, solely in order to expedite prosecution, Applicants have canceled claim 17 without prejudice or disclaimer and the rejection is moot.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claim 17.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection and submit that the invention as presently claimed in claims 1-16 is patentable and in condition for allowance.

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5. Conclusion Of Remarks

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For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.


If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

6. Authorization

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-558.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-558.

Respectfully submitted,


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